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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,138	04/08/2005	Werner Jaeger	127-75824	1950
23643 7590 08/20/2009 BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204				
EXAMINER				
MULLIS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

indocket@btlaw.com

Office Action Summary

Application No.

10/509,138

Applicant(s)

JAEGER ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-16 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Page 3, lines 21-25 make reference to the claims which is improper since the purpose of the specification is to describe the invention. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-16 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants argue that the term "consist essentially of" excludes chain transfer agents from the scope of the claims. If so applicants limitation "consist essentially of" is new matter since the specification as filed does not disclose that chain transfer agents should be excluded from applicants' product and process.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neff et al. (US 5882525) in view of (US 4713431, admission at page 1, lines 29-33 of the specification).

Patentees disclose a polymer which may contain applicants monomers "I" at column 4, lines 47-58 and 4-80 parts per million of a "branching agent" (see the paragraph bridging columns 3 and 4) such as PEGDMA of molecular weight of 600 (see experiments 10-11 in column 9). The materials may be used as flocculants agents for effluent in the treatment of sludges at column 1, lines 10-39.

There are no examples of a material produced by using patentees diallyl ammonium compounds in combination with applicants amounts of PEG dimethacrylate although patentees disclose that applicants amounts of branching agent which include PEGDMA may be used in amounts encompassing applicants' in combination with monomers including applicants. Hence it would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to select applicants components in applicants amounts from the disclosure of the patent in the expectation of adequate results absent any showing of surprising or unexpected results.

Patentees do not appear to disclose inverse emulsion polymerization as required by certain dependent claims. However page 1, lines 29-33 of applicants specification discloses that the advantage of inverse emulsion polymerization is known in the art for increasing molecular weights of flocculating polymers. Hence use of inverse emulsion polymerization would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to confer the advantage of increased molecular weight absent any showing of surprising or unexpected results.

The term "consisting essentially of" only excludes those materials which materially affect the novel and basic characteristics of a composition and it is applicants' burden to prove that such characteristics are changed by the presence of additional materials recited in a prior art product. Note In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893 (CCPA 1963) and In re De Lajarte, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964) in this regard.

Applicant's arguments filed 5-26-09 have been fully considered but they are not persuasive.

Applicants argue that the term "consist essentially of" excludes chain transfer agents or more than 1 branching agent from their claims. However the term "consisting essentially of" only excludes those materials which materially affect the novel and basic characteristics of a composition and it is applicants' burden to prove that such characteristics are changed by the presence of additional materials recited in a prior art product. Note In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893 (CCPA 1963) and In re De Lajarte, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964) in this regard. Furthermore the instant claims do not clearly recite only one branching agent and in fact recites "units". The primary reference uses a secondary alcohol as chain transfer agent and in fact it is known in the art in general that secondary alcohols act as chain transfer agents. Note in this regard Andrist et al. at paragraph 85, Osaka et al. at the paragraph bridging columns 6 and 7, Boon et al. at example 3, Vanderlaan et al. at the paragraph

bridging columns 3 and 4, Janssen at the last complete paragraph in column 5 and Erchak et al. at column 3, lines 26-45. Applicants own examples without exception use sorbitan containing materials (presumably added by applicants to function as surfactants) such as TWEEN and SPAN such as contain secondary alcohol functionality. Note also Rodrigues et al at paragraph 39 and Frenz at paragraph 85 who discloses that polyols act as chain transfer agents. Therefore the novel and basic characteristics can not be said to be exclusion of chain transfer agents nor can there said to be support for claims excluding chain transfer agent nor would those skilled in the art when viewing applicants specification as filed conclude that the novel and basic characteristics of applicants invention are affected by chain transfer agents. Also chain transfer agents are not monomers as applicants allege. While some chain transfer agents leave moieties of the agents reacted in the polymer which they are used to produce, there is no proof that secondary alcohols leave any such residue and applicants limitation "consist essentially of" therefore is immaterial to applicants' product claims.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis, M-F, 9-5 pm at telephone number 571 272 1075.

Application/Control Number: 10/509,138
Art Unit: 1796

Page 6

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Primary Examiner
Art Unit 1796

JCM

2-13-09

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Primary Examiner, Art Unit 1796